

R E M A R K S

Claims 1, 3 and 5-21 are pending in this application.

Claims 1 and 19 have been amended to more particularly describe the steps in the process.

Support for new claims 20-21 can be found on page 26, second paragraph.

No new matter has been added by way of the above-amendment.

The above-amendment does not narrow the scope of the invention and/or has not been made for the sake of patentability.

Interview

Applicants note with appreciation that the Examiner has conducted an Interview with Applicants' representative on November 4, 2004. The Examiner was very helpful in clarifying the issues.

On the Interview Summary form, the Examiner states:

The applicant pointed out to Examiner that the prior art discloses the formation of polymer using a desalting step which is excluded from the claimed invention. The newly proposed claimed language will be reconsidered in the next office action on the merits. (Edited for clarity).

We now provide a more detailed explanation of the results of the interview.

Issues under 35 U.S.C. 112

Claims 1-3 and 5-17 are rejected under 35 U.S.C. 112, second paragraph for being indefinite. Applicants respectfully traverse the rejection.

During the November 4, 2004 interview, the Examiner requested that we further clarify the steps in the method of claim 1 and in the method of claim 19 even though claim 19 is not included in the rejection. In response to the Examiner's comments, Applicants have amended claims 1 and 19 to clarify the steps of the process.

In view of the fact that the amended claims particularly point out and distinctly claim the subject matter that Applicants regard as the invention, withdrawal of the rejection is respectfully requested.

Issues under 35 U.S.C. 102 and 103

The following rejections are pending:

- a) Claims 1-3, 5-6 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0911691 (EP '691); and
- b) Claims 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '691 in view of Kato, Harring et al. and EP0803764 (EP '762).

Applicants respectfully traverse the rejections.

During the November 4, 2004 interview, the Examiner's comments in the outstanding Office Action were discussed. The Examiner appeared to be improperly viewing the claims as if they were in the product format and not in the process format. As the Examiner was respectfully reminded during the Interview, in order to distinguish from EP '691, Applicants amended the claims to be in the process format rather than the product format.

Applicants respectfully submit that patentability of the present invention lies in the fact that EP '691 fails to teach or fairly suggest a polymer latex having a low halogen content *which has not been purified through a desalting step*. Thus, the latex used in the inventive process has a low halogen content and the process does not include a step of purifying the polymer latex with a desalting step as is a requirement in EP '691. In fact, EP '691 only teaches purification with a desalting step and does not teach alternative means for purification as equivalents to the desalting step.

Also, during the Interview, the Examiner's comments at page 5, lines 3-6 were discussed. These comments are as follows:

The argument with respect to the results presented in Tables 2 and 3 of the present specification and reproduced on page 13 of the applicants' argument is not persuasive since these results are related to the halogen content (ppm) rather than the process for forming the polymer latex not subjecting to purification through desalting steps.

Again, Applicants' representative respectfully explained to the Examiner the point of these arguments with respect to the experimental results in the present specification. In Applicants' March 15, 2004 Amendment, Applicants argued that a desalting step of the polymer latex using an ion exchange resin or dialysis membrane results in an aggregation of the polymer latex due to dramatic changes in salt strength at the time of purification or concentration, and as a result, **the coating property is adversely**

affected. This adverse effect is not seen in the inventive process which does not include a desalting step.

At the conclusion of the Interview, the Examiner looked on Applicants' arguments with favor that the patentable distinction between the presently claimed invention and the teachings of EP '691 is the fact that the present invention is drawn to a method of forming the photothermographic material. However, the Examiner required further time to make a final decision.

In view of the foregoing arguments, Applicants respectfully request that the Examiner withdraws the rejections.

Conclusion

In view of the above-amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A Notice to such effect is earnestly solicited.


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$980.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.**, (Reg. No. 43,575) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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